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TO: Art Unit 2183	Fax No.: 571 273 8300	Telephone No.: 571 272 4165
U.S. Patent and Trademark Office	City: Alexandria	State: Virginia
TO: Examiner Richard Ellis	Fax No.: 571 273 4165	Telephone No.: 571 272 4165
U.S. Patent and Trademark Office	City: Alexandria	State: Virginia

CONCERNING APPLICATION:

Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/385,394

Art Unit: 2183

Filed: August 30, 1999

Examiner: Richard Ellis

Title: COMPUTER WITH TWO EXECUTION MODES

I hereby certify that the attached

- This FAX cover sheet
- Request to Correct PALM and IFW Information

along with any paper(s) referred to as being attached or enclosed) are being transmitted by facsimile on August 1, 2006 to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: August 1, 2006

By:

David E. Boundy

Registration No. 36,461

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PATENT

ATTORNEY DOCKET NO. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/385,394 Confirmation No.: 9093
Applicant: John S. Yates, Jr., et al.
Title: COMPUTER WITH TWO EXECUTION MODES
Filed: August 30, 1999
Art Unit: 2183
Examiner: Richard Ellis

Atty. Docket: 114596-03-4000
Customer No. 38492

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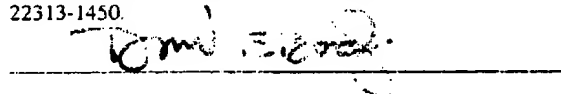
REQUEST TO CORRECT PALM AND IFW INFORMATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant observes that the status of the application as noted in PALM and the IFW system as of July 31, 2006 is incorrect.

The "Status" is currently "Appeal Brief (or Supplemental Brief) Entered and Forwarded to Examiner." This is not correct. The correct status is most likely "Response to Non-Final Office Action Entered and Forwarded to Examiner." As discussed in the Response to Notice of Non-Compliant Appeal Brief of June 13, 2006, when considered in combination with the "Petition to the Director Regarding Premature Final Rejection" of January 9, 2006 and "Petition for Extension of Time" of November 28, 2005, the PTO has waived final rejection and reopened prosecution. By dismissing petitions as "moot," the PTO has waived any disagreement with Applicant's allegations, and accepts responsibility for "eradicating" all effects of those allegations. *County of Los Angeles v. Davis*, 440 U.S. 625, 631 (U.S. Sup. Ct. 1979). Those

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Request to Correct PALM and IFW Information
This paper dated August 1, 2006

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114596-03-4000

S/N 09/385,394
3352107.1

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
This Paper Dated August 1, 2006

effects can only be "eradicated" if final rejection is withdrawn, and the November 2005 paper is entered as a response to non-final action.

The IFW should be corrected to change the 83-page paper of 12/1/2005 (mailing date November 28, 2005) from "Appeal Brief" to "Response to Non-Final Action." On the current state of the record, the paper of November 28, 2005 captioned "Response to Office Action or in the Alternative Appeal Brief" is an ordinary Rule 111 response to non-final Office Action. The eventuality that would convert this paper to an Appeal Brief in the alternative has not occurred – the paper remains a "Response to Office Action." Further, by dismissing certain petitions as "moot," the PTO has waived any disagreement with the request that this paper be entered as a Rule 111 Response. *Los Angeles*, 440 U.S. at 631.

Applicant notes that two papers are now pending: the "Response to Office Action or in the Alternative Appeal Brief" of November 28, 2006, and the 3-page paper captioned "Fourth Response to Office Action" of the same date. Both papers are properly considered under Rule 111.

This application has now been pending **seven years**. Applicant suggests that the time is now ripe for the application to receive a complete examination. For any claim that is not allowed, it would now be appropriate to either identify an explicit correspondence to the references (including **both** a "designation of portions relied on" and a clear explanation of "pertinence," 37 C.F.R. § 1.104(c)(2)), or to provide a showing of inherency. If either of these is not set forth on paper, an examiner is permitted to allow claims. The PTO does not favor "rework," and "rework" can only come to an end when the examiner does one of these three on paper, instead of maintaining radio silence and leaving an applicant to guess at positions the examiner has not expressed. Similarly, the application can only make progress when the examiner expresses a view on all elements of any *prima facie* case, for example, the three showings required for obviousness set forth in MPEP § 2143.

Application Serial No. 09/385,394
Attorney Docket No. 114596-03-4000
This Paper Dated August 1, 2006

Applicant further notes that if the next paper raises any "new ground of rejection," as that term is defined by the Federal Circuit and Board of Patent Appeals,¹ the next Action may not be made final.

Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: August 1, 2006

By: 

David E. Boundy
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¹ See "Supplement to Petition," October 31, 2005, at pages 2-4 and "Petition to Director Regarding Premature Final Rejection" of January 9, 2006 at pages 7-9. If the Examiner believes he has authority to redefine legal terms of art in such manner as to disregard or overrule the Federal Circuit and Board, Applicant requests a written document that states that authority.